17-460

TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

No. ~~526.~~ 476

FRANKLIN PHILP AND ADOLPHUS S. SOLOMONS, PLAINTIFFS IN ERROR,

vs.

JOSEPH NOCK.

IN ERROR TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

FILED DECEMBER 11, 1871.

SUPREME COURT OF THE UNITED STATES.

No. 526.

FRANKLIN PHILP AND ADOLPHUS S. SOLOMONS, PLAINTIFFS IN ERROR,

vs.

JOSEPH NOCK.

IN ERROR TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

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1 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the chief justice and justices of the supreme court of the District of Columbia, greeting:

Because in the record and proceedings, as also in the rendition of a judgment in a plea which is in the said court before you, between Joseph Nock, plaintiff, and Franklin Philp and Adolphus S. Solomons, trading as Philp & Solomons, defendants, a manifest error hath happened, to the great damage of the said defendants, as by their complaint appears; and it being fit that the error, if any hath happened, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf: Therefore, you are hereby commanded, if judgment be therein given, under your seal, distinctly and openly, to send the record and proceedings aforesaid, with all things concerning the same, to the Supreme Court of the United States, together with this writ, so that you have the same at Washington on the first Monday of December next, in the said Supreme Court to be then and there held, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right and according to the law and custom of the United States should be done.

Witness the Honorable Salmon P. Chase, Chief Justice of the United States, this 21st day of December, in the year of our Lord 1870, and of the independence of the United States the 95th.

[SEAL.] R. J. MEIGS, *Clerk.*

DISTRICT OF COLUMBIA, *to wit:*

To JOSEPH NOCK:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States to be holden at Washington on the first Monday of December next, pursuant to a writ of error filed in the clerk's office of the supreme court of the District of Columbia, wherein Franklin Philp & Adolphus Solomons, trading as Philps & Solomons, are plaintiffs, and you are defendant, to show cause, if any there be, why the judgment in the said writ of error mentioned should not be corrected, so that speedy justice be done the parties in that behalf.

Witness D. K. Cartter, chief justice of the said supreme court of the District of Columbia.

D. K. CARTTER,
Ch'f Justice.

I admit service of this citation & copy of writ of error.

JOSEPH NOCK.

DEC'R 26, 1870.

Teste:
R. J. MEIGS, *Clk.*

(Indorsed:) 5438. Law. Joseph Nock v. Philp & Solomon. Citation.

REC. 526—1

2 *Declaration.—Filed Jan'y 8th, 1869.*

In the supreme court of the District of Columbia, January 8th, A. D. 1869.

JOSEPH NOCK
vs.
FRANKLIN PHILP, AND ADOLPHUS S. SOLOMONS, partners, under the name and style of Philp & Solomons. } At law. No. 5438.

The plaintiff, Joseph Nock, sues the defendants, Franklin Philp and Adolphus S. Solomons, partners, doing business under the name and style of Philp & Solomons, for that the plaintiff was the original and first inventor of a certain new and useful hinge for inkstand covers, and thereupon letters-patent were duly issued to the plaintiff, granting to him, his heirs, administrators, or assigns, for the term of fourteen years from the 13th day of December, A. D. 1853, the full and
3 exclusive right and liberty of making, using, and vending to others to be used, the said invention. And the Commissioner of Patents did, on the 10th day of December, A. D. 1867, and before the expiration of said original term, renew and extend said patent for the term of seven years from the 13th day of December, 1867, and the said defendants did, within the term of said original patent, and have since, within said term, infringed the said patent-right, and the plaintiff claims $5,000 damages.

By S. S. HENKLE,
His Attorney.

The defendants are to plead hereto on or before the first special term of the court, occurring twenty days after service hereof; otherwise judgment.

S. S. HENKLE,
Attorney for Plaintiff.

4 *Summons.—Issued Jan'y 8th, 1869.*

In the supreme court of the District of Columbia, the 8th day of January, 1869.

JOSEPH NOCK, PLAINTIFF,
vs.
FRANKLIN PHILP & ADOLPHUS S. SOLOMONS, defendants. } At law. No. 5438.

The President of the United States to the marshal for said District, greeting:

Summon the defendants in the above-entitled case to appear in said court on or before the first special term thereof occurring twenty days after service of this writ, and answer the declaration herewith served, and warn *him* that, on default of so doing, the plaintiff may proceed to judgment and execution at the trial term of said court next after said service. And do you return this writ into the clerk's office immediately after service, so indorsed as to show the time and manner of executing

it, and if you cannot serve it within six months, the day of its issuance exclusive, then return it into said office for renewal.

Witness D. K. Cartter, chief justice of said court.

R. J. MEIGS, *Clerk.*

HENKLE.

5 NOTE.—That the special terms of the court commence on the first Tuesday of every month, except May, in which month they commence on the third Monday, and August, in which month there is no term of the court; and that the trial terms of the court commence on the first Tuesday of February, third Monday of May, and first Tuesday of November, when final judgments may be taken, and execution awarded.

Marshal's return.

The 11 day of Jan'y, 1869, then served copies of the declaration, notice to plead, and summons on the defendant'.

Defendants' plea.—Filed 18th Jan'y, 1869.

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

The defendants say they are not guilty as alleged.

A. POLLOK, AND
R. D. MUSSEY,
Attorneys for Defendants.

6 *Joinder in issue.—Filed 5th Feb'y, 1869.*

In the supreme court of the District of Columbia, February 5th, 1869.

JOSEPH NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

The plaintiff joins issue upon the defendants' plea.

S. S. HENKLE,
Att'y for Plff.

Defendants' amended plea.—Filed February 12, 1869.

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

1st. The defendants deny that they are guilty, as alleged.

2d. And, for a further plea, they say that the said original letters-patent, obtained by said Nock, were void, because of false suggestion,

and because there was no patentable invention described in his specification and claim.

7 3d. And for a further plea, they say that said extension of said letters-patent was obtained illegally and fraudulently.

POLLOK & MUSSEY,
Attorneys for Defendants.

Replication.—Filed Dec'r 29, 1869.

In the supreme court of the District of Columbia.

JOSEPH NOCK
vs.
PHILP & SOLOMON. } At law. No. 5438.

The plaintiff joins issue upon the defendants' first, second, and third pleas.

H. STOCKBRIDGE.

Proceedings before the supreme court of the District of Columbia, holding a circuit court and special term, commencing on the 4th Monday, 24th day of January, 1870.

MONDAY, *January 24th*, 1870.

Session resumed pursuant to rule of court, Chief Justice Cartter presiding.

8 THURSDAY, *March 3d*, 1870.

Session resumed pursuant to adjournment, Chief Justice Cartter presiding.

JOSEPH NOCK, PL'FF,
vs.
FRANKLIN PHILP, ADOLPHUS S. SOLOMONS, trading as Philp & Solomons. } 5438. At law.

And now comes as well the plaintiff, by his attorney, Mr. Stockbridge, as the defendants, by their attorneys, Messrs. Pollok & Mussey, and a jury of good and lawful men of this District, to wit: William Barnes, John Coulson, Robert J. Nicholson, Edward A. Dickens, J. Russell Barr, John W. Mead, Steptoe T. Tune, John J. Mulloy, William A. King, Daniel G. Mallory, Thomas E. Jacobs, and William Harris, who being sworn to try the issue above joined, are respited until the meeting of the court to-morrow.

9 SATURDAY, *March 5th*, 1870.

Session resumed pursuant to adjournment, Chief Justice Cartter presiding.

JOSEPH NOCK, PL'FF,
vs.
FRANKLIN PHILP & ADOLPHUS S. SOLOMONS, trading as Philp & Solomons. } 5438. At law.

And now again come the parties aforesaid, in manner aforesaid, and

the same jury that was respited yesterday, who after receiving the charge of the court, on their oath say they find the issue aforesaid, in favor of the plaintiff, and assess his damages by reason of the premises at the sum of five hundred dollars, besides costs.

And thereupon the plaintiff, by his said attorney, moves the court to treble the damages awarded by the jury in this case, as provided by the act of Congress; and the defendants, by their said attorneys, give notice that they will file a motion for a new trial.

10 MONDAY, *March 7th*, 1870.

Session resumed pursuant to adjournment, Chief Justice Cartter presiding.

NOCK
vs. } 5438. At law.
PHILP & SOLOMONS.

And now come the defendants, by their attorney, Mr. Mussey, and file their written motion to set aside the verdict aforesaid, and for a new trial of the issue joined, upon exceptions to the rulings of the court upon the trial; and because the evidence was insufficient to maintain said verdict; and because the damages assessed by the jury are excessive.

SATURDAY, *April* 23, 1870.

Session resumed pursuant to adjournment, Chief Justice Cartter presiding.

NOCK
vs. } 5438. At law.
PHILP & SOLOMONS.

11 On argument of the plaintiff's aforesaid motion to treble the damages found by the jury aforesaid, and of the defendants' aforesaid motion for a new trial, it is ordered by the court that both motions be, and the same are hereby, overruled.

First bill of exceptions.

In the supreme court of the District of Columbia.

NOCK
vs. } At law. No. 5438.
PHILP & SOLOMONS.

Upon the trial of this cause, to maintain and prove the issue thirdly above joined, the counsel for the defendants gave in evidence to the jury that the principal examiner, to whom the plaintiff's application for said extension of said patent was referred for report, and specially whether the invention or improvement secured in the patent was new and patentable when granted, had reported to the Commissioner as follows, viz:

UNITED STATES PATENT OFFICE,
November 25, 1867.

To the Hon. T. C. THEAKER,
Commissioner of Patents:

In the matter of the application of Joseph Nock for an extension of

his patent No. 10310, granted December 13, 1853, for an inkstand cover, the examiner in charge has the honor to report that the device in question, which consists in giving an external curvilinear form to an otherwise ordinary hinge, is not and was not patentable when granted.

Locket and watch cases, table furniture, such as Britannia sirup-cans, teapots, and many other familiar articles, have hinges constructed in form as nearly approaching the curved shape of the article itself as is consistent with the strength and practical working of the hinge. The axis of this (as of every possible hinge) must from necessity be a straight cord to the arc formed by the external shape of the joint.

No effect beyond that of mere appearance, which depends upon taste or caprice, is produced by the form of the hinge under consideration, which effect is of very questionable patentability, if not absolutely devoid of it, except, perhaps, under the design act.

The invention is, therefore, considered to be deficient in novelty, in patentable effect, and in "value and importance" to the public, and on these grounds it is thought that the extension asked for should be refused.

Respectfully submitted.

A. S. STEWART, *Examiner.*

And further offered to prove that the application and other papers relating to the said extension had been taken from the files of the Patent Office.

Whereupon the counsel for the plaintiff objected to the introduction of such evidence, and the said justice thereupon held and affirmed that the said evidence was not good and admissible in law, and refused to allow the same to be given to the jury.

Whereupon the counsel for the defendants made his exceptions to the said opinion of the said justice (who noted the same upon his minutes) before the giving of the verdict.

And the said counsel requests said justice to put his seal to this his first bill of exceptions, containing the said several matters so proved and offered in evidence by the defendants, and the said opinion of the said justice thereon. And the said justice, now for then, puts his seal hereto, the 7th day of May, 1870.

D. K. CARTTER, [L. S.]
Chief Justice.

12 *Second bill of exceptions.*

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

At the trial of this cause, to maintain the issues above joined, the counsel for the plaintiff gave in evidence to the jury that, on the 13th of December, 1853, the plaintiff procured letters-patent of the United States, No. 10310, for an improved hinge for inkstand covers, which said letters-patent were extended on the 10th of December, 1867, for the term of seven years, and that from September, 1867, to January, 1869, the said letters-patent and said extended letters-patent were in the possession of the plaintiff, and that during said period, from September,

1867, to January, 1869, the defendants had sold inkstands having hinges that were infringements of said plaintiff's patent, to the number of seventy-five dozen, and that the royalty which the plaintiff received for the use of his patent was at the rate of $2 per gross; and thereupon the plaintiff's counsel prayed the said justice to instruct the jury:

The plaintiff prays the court to instruct the jury that—

If they are satisfied from the evidence that the plaintiff was the original and first inventor of a new and useful hinge for inkstand covers, and obtained for such invention, from the United States Patent Office, letters-patent for a term of years, which, by the original grant thereof, or by extension, has not yet expired—

And are further satisfied that, since the issuing of said letters-patent, and during said term of years, and while the plaintiff was the owner of his said patent, the defendants have made, or caused to be made or sold for use, inkstand-covers, or inkstands with covers, which, on principle and construction, are substantially the same as the invention so patented by the plaintiff, then the plaintiff is entitled to recover in this action.

And in deciding the usefulness of said invention, if the jury shall find that the invention was in no way mischievous or injurious to the public, and by its use enabled manufacturers of inkstands with hinged covers to place the same in market at less cost, or with more expedition than by the methods previously known, then the invention is useful within the meaning of the law. Granted.

If the jury shall find a verdict for the plaintiff under the foregoing instructions, they will award him such sum as they shall find to be required to remunerate him for the loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have been necessarily incurred by him in order to establish his right. Granted.

And the said justice further instructed said jury:

Instruction of court.

If the jury shall find from the testimony that the contrivance in issue before them, a monopoly of which is secured to the plaintiff by letters-patent, was new and useful; and if the jury shall further find that the inkstands bought and sold by the defendants were an infringement upon the patent of the plaintiff, they will find for the plaintiff, unless they shall further find that the plaintiff himself, or by his assignees or agents, on consideration, authorized the manufacture and sale of the same.

To which prayers and instruction the defendants' counsel objected, and requested the said justice to reject said prayers, and not to deliver said instruction, which request the said justice refused, and gave the instructions as prayed by the plaintiff's counsel, and said additional instruction; whereupon the counsel for the defendants made his exceptions to the said direction of the said justice, (who noted the
13 same upon his minutes,) before the giving of the verdict; and the said counsel requests said justice to put his seal to this his second bill of exceptions, containing the said opinion and direction of the said justice; and the said justice, now for then, puts his seal hereto, the 7th day of May, A. D. 1870.

D. K. CARTTER, [L. S.]
Chief Justice.

Third bill of exceptions.

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

Upon the trial of this cause, the defendants, having given in evidence to the jury the report of the principal examiner on the application of the plaintiff for an extension of the term of the letters-patent, granted to him for an improved hinge for inkstand covers, dated December 13, 1853, and numbered 10310; which report is as follows, viz:

UNITED STATES PATENT OFFICE,
November 25, 1867.

To the Hon. T. C. THEAKER,
Commissioner of Patents.

In the matter of the application of Joseph Nock for an extension of his patent No. 10310, granted December 13, 1853, for an inkstand cover, the examiner in charge has the honor to report, that the device in question, which consists in giving an external curvilinear form to an otherwise ordinary hinge, is not, and was not patentable when granted.

Locket and watch cases, table-furniture, such as Britannia sirup-cans, teapots, and many other familiar articles, have hinges constructed in form as nearly approaching the curved shape of the article itself as is consistent with the strength and practical working of the hinge. The axis of this, (as of every possible hinge,) must from necessity be a straight cord to the arc formed by the external shape of the joint.

No effect beyond that of mere appearance, which depends upon taste or caprice, is produced by the form of the hinge under consideration, which effect is of very questionable patentability, if not absolutely devoid of it, except, perhaps, under the design act.

The invention is, therefore, considered to be deficient in novelty, in patentable effect, and in "value and importance" to the public, and on these grounds it is thought that the extension asked for should be refused.

A. S. STEWART, *Examiner.*

Prayed the said justict to instruct the jury:

"That if the jury shall find from the evidence that the application of the plaintiff for an extension of his letters-patent was, under the law, referred to the principal examiner having charge of the class of inventions to which said case belonged, and that he reported to the Commissioner of Patents that the invention or improvement secured in the patent was not new or patentable when patented, and that if the Commissioner of Patents thereupon extended said patent without reasons assigned for overruling the report of the examiner, and without a further examination into the claims of the invention or improvement secured by the letters-patent to novelty or patentability at the time the patent was secured, then such extension was irregular and illegal, and the plaintiff cannot recover on such extended letters-patent."

Which request the said justice rejected, and refused to so instruct the said jury. Whereupon the counsel for the defendants made his exceptions to the said refusal of the said justice (who noted the same on

his minutes,) before the giving of the verdict; and the said counsel requested the said justice to put his seal to this his third bill of exceptions, containing said several matters so proved and given in evidence on part of the defendants, and said prayer for instructions, and the said opinion and refusal of the said justice thereon And the said justice, now for then, put his seal hereto the 7th day of May 1870.

D. K. CARTTER, [L. S.]
Chief Justice.

14 *Fourth bill of exceptions.*

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

Upon the trial of this cause to maintain the issues above joined, the defendants gave evidence to the jury, tending to show that inkstands, similar to those sold by the defendants, were commonly made and sold by assignees and licensees of the plaintiff, up to September, 1867, and thereupon counsel for the defendants prayed the said justice to instruct the jury:

"That if the jury shall find from the evidence that the inkstands which form the subject of this patent were commonly made and sold by the assignees and license's of the plaintiff, up to September, 1867, then the plaintiff cannot recover for the sale of any such inkstands sold by the defendants."

Which prayer the said justice rejected, and refused to so instruct the jury. Whereupon the counsel for the defendants made his exceptions to the said refusal of the said justice to so instruct the jury (and the said justice noted the same upon his minutes) before the giving of the verdict; and the said counsel requested the said justice to put his seal to this his fourth bill of exceptions, containing said several matters so given in evidence by said defendants, and said prayer and the refusal of said justice to so instruct the jury.

And the said justice, now for then, puts his seal hereto, the 7th day of May, 1870.

D. K. CARTTER, [L. S.]
Chief Justice.

Fifth bill of exceptions.

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

At the trial of this cause upon the issues above joined, the defendants gave evidence to the jury, tending to show that inkstands made in accordance with the plaintiff's said patent were commonly sold in the trade, without being stamped or labeled "Patent," prior and subsequent to September, 1867; and, further, the defendants gave evidence to the jury, tending to show that the said defendants, when notified by the said plaintiff that the inkstands they were selling were infringe-

ments of his said patent, ceased selling them, and thereupon the defendants' counsel prayed the said justice to instruct the jury:

"That if the jury find from the evidence that inkstands made in accordance with Nock's patent were commonly sold in the trade, without being stamped or labeled, prior and subsequent to September, 1867, then the defendants are not liable, unless notice was served upon them by the patentee, and damages can only be recovered for sales made after such notice.

And the said justice rejected said prayer, and refused to instruct the said jury.

Whereupon the counsel for the defendants made his exceptions to the said refusal of said justice (who noted the same upon his minutes) before the giving of the verdict; and the said counsel requests said justice to put his seal to this his fifth bill of exceptions, containing said several matters so proved and given in evidence on part of the defendants, and the said prayer of the said defendants' counsel, and the said refusal of the said justice so to charge the jury.

And the said justice puts his seal hereto, now for then, the 7th day of May, 1870.

D. K. CARTTER, [L. S.]
Chief Justice.

15 *Sixth bill of exceptions.*

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

Upon the trial of this cause, upon the issues above joined, the plaintiff having given in evidence to the jury the said letters-patent granted to said Joseph Nock, under date of December 13, 1853, numbered 10310, and extended on the 10th of September, 1867, for the term of seven years from the 13th of December, 1867, which said letters-patent are as follows, viz:

No. 10310.

The United States of America to all to whom these letters-patent shall come:

Whereas Joseph Nock, of Philadelphia, Pennsylvania, has alleged that he has invented a new and useful hinge for inkstand covers, which he states has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said hinge, and that the same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the Treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said hinge, and praying that a patent may be granted for that purpose:

These are therefore to grant, according to law, to the said Joseph Nock, his heirs, administrators or assigns, for the term of fourteen years from the thirteenth day of December, one thousand eight hundred and fifty-three, the full and exclusive right and liberty of making, con-

structing, using, and vending to others to be used, the said hinge; a description whereof is given in the words of the said Nock in the schedule hereunto annexed, and is made part of these presents.

In testimony whereof I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

Given under my hand, at the city of Washington, this thirteenth day of December, in the year of our Lord one thousand eight hundred and fifty-three, and of the independence of the United States of America the seventy-eighth.

[L. S.] ROBERT McCLELLAND,
Secretary of the Interior.

Countersigned and sealed with the seal of the Patent Office.

C. MASON,
Commissioner of Patents.

The schedule referred to in these letters-patent, and making part of the same.

To all whom it may concern:

Be it known that I, Joseph Nock, in the city and county of Philadelphia, and State of Pennsylvania, have invented a new and useful inkstand and ink-well cover, and I do hereby declare that the following is a full and exact description thereof, reference being had to the accompanying drawings and to the letters of reference marked thereon.

The nature of my invention consists in providing the inkstand or ink-well cover with a curvilinear hinge on the top of the inkstand or ink-well cover, which cover is to be closed, to form a round or smooth-turned face, and gives an opportunity of cleaning when soiled, inside as well as outside; and can be used by any scholars in the public schools, or any other places where writing-ink is to be used, as it is the most convenient in opening and shutting, and, of course, keeps the ink clean, and saves the ink from evaporating when shut.

16 And the manner of which I construct the hinge is, with one solid part, as the moving lid (Figure "*a*") and the other part is hollow, being cast or stamped of sheet brass or other material, (Figure "*b*,") forming, when put together and shut, a regular round hinge, and is flat on the bottom, and can be applied on any flat surface, desk, table, or inkstand; the only difference is, that it is to be screwed on wood, but cemented on glass, iron, stone, or other hard substances. Those that are cemented do not require as broad a rim as those on wood; and, also, the bottom rim inside requires to be broad, in order to hold the ink-well of glass. But I change the inside of the bottom part, in order to get a better hold for the cementing on hard substances, by bending it downwards or otherwise. This hinge is constructed like any other hinge, with the exception only that the pin is laid in the hollow part, from the under side, and with soft solder both ends of the pin are soldered fast, and the solid moving lid has the hole for the pin or axis of the hinge drilled through the hinge part, as shown in the pattern correctly.

What I claim as my invention, and desire to secure by letters-patent, is the application of the stamped round part and the solid part (or the moving lid or cover) fitted together as a hinge, which forms a rounded smooth-turned face, and the manner in which the pin is connected with both parts, as herein described, using for that purpose the aforesaid

"two pieces, to form a regular curvilinear or round-turned hinge," made of any materials which will produce the intended effect.

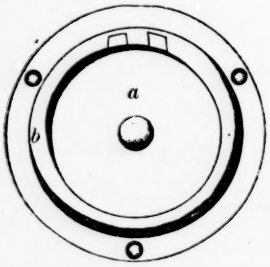
JOSEPH NOCK.

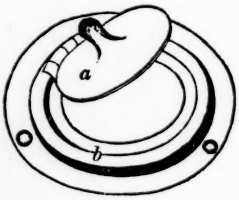
Witnesses:
JOHN A. ELKINTON.
JOHN WHISM.
PHILADELPHIA, *August* 27, 1850.

JOSEPH NOCK.

Hinge for inkstand covers.

Patented Dec. 13, 1853.] [No. 10310.





Inventor:

JOSEPH NOCK.

17 And the defendants having given evidence to the jury tending to prove that in the hinges of the inkstands sold by the defendants, and alleged to be infringements of the plaintiff's said patent, the pin or axis of the hinge was introduced from the outside of the collar, passing through the collar and the loop of the cover—

And thereupon the counsel for the said defendants requested the said justice to instruct the jury:

"That the patentee having, in his specification of the letters-patent in controversy, declared that his 'hinge is constructed like any other hinge, with the exception only that the pin is laid in the hollow part from the under side, and with soft-solder both ends of the pin are soldered fast, and the solid moving lid has the hole for the pin or axis of the hinge drilled through the hinge part, as shown in the pattern correctly,' unless the jury shall find that the hinges of the inkstands sold by the defendants were so constructed, there is no proof of infringement, and that there is no infringement of the plaintiff's patent if the pin is introduced from the outside of the collar, passing through the collar and the loop of the cover."

Which request the said justice rejected, and refused to instruct the jury, as requested; and thereupon the counsel for defendants made his exceptions to the said refusal of said justice (who noted the same upon his minutes) before the giving of the verdict.

And the said counsel requests said justice to put his seal to this, his sixth bill of exceptions, containing said several matters so proven and given in evidence on the part of the plaintiff and on the part of the defendants, and the said prayer of the defendants thereupon, and the said justice's refusal to direct the jury as so prayed.

And the said justice puts his seal hereto, now for then, the 7th day of May, 1870.

D. K. CARTTER, [L. S.]
Chief Justice.

Seventh bill of exceptions.

In the supreme court of the District of Columbia.

NOCK
vs.
PHILP & SOLOMONS. } At law. No. 5438.

Upon the trial of this cause upon the issues above joined, the plaintiff having given evidence to the jury tending to show that, between September, 1867, and January, 1869, the plaintiff was in possession of and controlled the said letters-patent, No. 10310, issued to the said plaintiff for improvement in hinges to inkstands, which said letters-patent were subsequently, viz, on the 10th day of December, 1867, extended for the term of seven years from December 13, 1867. And further, that, during the said period, from September, 1867, to January, 1869, the said defendants had sold seventy-five dozen inkstands, which were an infringement of said patent. And further, that the plaintiff had obtained from licensees, under the said extended term of his said patent a royalty of $2 00 per gross.

And thereupon the counsel for the defendants requested the said justice to instruct the jury:

"That if the jury shall find for the plaintiff, the amount of damages assessed shall not exceed the royalty received by the plaintiff from the licensees under the extended patent, on the number of inkstands and ink-wells proved to have been sold by the defendants between September, 1867, and January, 1869."

Which request the said justice rejected, and refused to so instruct the said jury.

18 And thereupon the counsel for the defendants made his exceptions to the said refusal of the said justice (who noted the same upon his minutes) before the giving of the verdict.

And the said counsel for the defendants requests said justice to put his seal to this his seventh bill of exceptions, containing the said several matters so proved and given in evidence on the part of the plaintiff, and the said prayer of the defendants' counsel for instruction to the jury thereupon, and the said refusal of the said justice to so instruct said jury.

And the said justice, now for then, puts his seal hereto, the 7th day of May, 1870.

D. K. CARTTER, [L. S.]
Chief Justice.

Proceedings before the supreme court of the District of Columbia in general term, commencing the 4th Monday, 26th of September, 1870.

MONDAY, *September 26th*, 1870.

By order of the justices, opening of the court proclaimed by the marshal—present, Justices Olin, Wylie, Humphreys, and MacArthur; absent, Chief Justice Cartter.

JOSEPH NOCK
vs. } No. 5438. At law.
PHILP & SOLOMONS.

On motion of the defendants, by Mr. Mussey, their attorney, it is ordered that this cause be placed on the calendar of this term.

19 FRIDAY, *October* 28, 1870.

Session resumed pursuant to adjournment—present, Chief Justice Cartter and Justices Olin, Wylie, Humphreys, and MacArthur.

NOCK
vs. } 5438. At law.
PHILP & SOLOMONS.

The plaintiff's motion to strike this case from the calendar having been argued by Mr. Cottrell for plaintiff, and Mr. Mussey for the defendants, the same is overruled.

WEDNESDAY, *November* 23, 1870.

Session resumed pursuant to adjournment—present, Chief Justice Cartter and Justices Olin and MacArthur.

NOCK
vs. } 5438. At law.
PHILP & SOLOMONS.

Argued by Mr. Mussey for the defendants, and by Mr. Nock in p. p.

20 MONDAY, *December* 19*th*, 1870.

Session resumed pursuant to adjournment—present, Chief Justice Cartter and Justices Olin and MacArthur.

JOSEPH NOCK
vs.
FRANKLIN PHILP AND ADOLPHUS S. SOLOMONS, partners, under the name and style of Philp & Solomons. } At law. No. 5438.

And now again come here the plaintiff in proper person, and the defendants by their attorney aforesaid; and because it seems to the court that there is no error either in the record or proceedings of the circuit court, it is thereupon considered that the plaintiff recover against the said defendants five hundred dollars, the damages aforesaid, in manner and form aforesaid found, with interest thereon from March 5th, 1870, and $, costs of suit, and have execution thereof.

21 In the supreme court of the District of Columbia, the 21 day of December, 1870.

JOSEPH NOCK
vs.
FRANKLIN PHILP AND ADOLPHUS S. SOLOMONS, trading as Philp & Solomons. } At law. No. 5438. In error.

Know all men by these presents that we, , are bound unto the above-

named Joseph Nock in the sum of one thousand dollars, to be paid to the said Joseph Nock, his executors, or administrators; to which payment, well and truly to be made, we bind ourselves, and each of us, jointly and severally, and our, and each of our heirs, executors, and administrators, firmly by these presents, sealed with our seals, and dated this 21 day of December, 1870.

Whereas the above-named Franklin Philp and Adolphus S. Solomons, trading as Philp & Solomons, have prosecuted a writ of error to the Supreme Court of the United States to reverse the judgment rendered in the above suit by the said supreme court of the District of Columbia:

Now, therefore, the condition of this obligation is, that if the above-named Franklin Philp and Adolphus S. Solomons shall prosecute their said writ of error to effect, and answer all damages and costs if he shall fail to make good his plea, then this obligation shall be void; otherwise the same shall be and remain in full force and virtue.

FRANKLIN PHILP. [SEAL.]
ADOLPHUS S. SOLOMONS. [SEAL.]
JAMES P. CHAPMAN. [SEAL.]

Sealed and delivered in presence of—
WARREN CHOATE.

Approved this 21st day of December, A. D. 1871.
McARTHUR, *Justice.*

22 DISTRICT OF COLUMBIA, *to wit:*

I, Return J. Meigs, clerk of the supreme court of the District of Columbia, do hereby certify that originals, of which the foregoing writings are true and complete copies, are on file and of record in the clerk's office of said court, and that said originals together constitute the record of the proceedings of said court in a case therein depending and lately decided, entitled Joseph Nock vs. Franklin Philp and Adolphus S. Solomons, trading as Philp & Solomons, No. 5438, at law.

I do further certify that the original writ of error and original citation are prefixed thereto.

In testimony whereof I have hereunto set my hand and affixed the seal of said court this 4th day of December, A. D. 1871.

[SEAL.] R. J. MEIGS, *Clerk.*

(Indorsement on cover:) No. 526. Franklin Philp and Adolphus S. Solomons, plaintiffs in error, v. Joseph Nock. Dist. of Columbia sup. court. Filed 11th December, 1871.

Supreme Court of the United States.

OCTOBER TERM, 1873.

PHILP & SOLOMONS, PLAINTIFFS IN ERROR,

vs.

NOCK, DEFENDANT IN ERROR.

BRIEF FOR PLAINTIFFS IN ERROR.

R. D. MUSSEY,
For Plaintiffs in Error.

Supreme Court of the United States.

OCTOBER TERM, 1873.

PHILP & SOLOMONS, PLAINTIFFS IN ERROR,

vs.

NOCK, DEFENDANT IN ERROR.

BRIEF FOR PLAINTIFFS IN ERROR.

The Facts.

This case comes up from the Supreme Court of the District of Columbia by writ of error.

The suit was brought by Joseph Nock, in January, 1869, against F. Philp & A. S. Solomons, the well known stationers of this city, during the extended term of a patent to recover damages for alleged infringement of the same.

The original patent was issued December 13, 1853, to Joseph Nock, for a hinge for inkstand covers, and was extended on the 10th December, 1867, for seven years from December 13, 1867. The patent is set out on pages 10, 11, 12 of the (printed) Record.

The specification and claim are as follows:

Be it known that I, Joseph Nock, in the city and county of Philadelphia, and State of Pennsylvania, have invented a new and useful *inkstand* and *ink well-cover*, and I do hereby declare that the following is a full and exact description thereof, reference being had to the accompanying drawings and to the letters of reference marked thereon.

The nature of my invention consists in providing the ink-

stand or ink well-cover with a *curvilinear hinge* on the top of the inkstand or ink well-cover, which cover is to be closed, to form a round or smooth-turned face, and gives an opportunity of cleaning when soiled, inside as well as outside; and can be used by any scholars, in the public schools, or any other places where writing ink is to be used, as it is the most convenient in opening and shutting, and of course keeps the ink clean, and saves the ink from evaporating when shut.

And the manner of which I construct the hinge is, with one solid part, as the moving lid, (figure "*a*,") and the other part is hollow, being cast or stamped of sheet brass or other material (figure "*b*,") forming, when put together and shut, a regular round hinge, and is flat on the bottom, and can be applied on any flat surface, desk, table, or inkstand; the only difference is, that it is to be screwed on wood, but cemented on glass, iron, stone, or other hard substances. Those that are cemented do not require as broad a rim as those on wood; and, also, the bottom rim inside requires to be broad, in order to hold the ink-well of glass. But I change the inside of the bottom part, in order to get a better hold for the cementing on hard substances, by bending it downwards, or otherwise. This hinge is constructed like any other hinge, with the exception only, that the pin is laid in the hollow part, from the under side, and with soft solder both ends of the pin are soldered fast, and the solid moving lid has the hole for the pin or axis of the hinge drilled through the hinge part, as shown in the pattern correctly.

What I claim as my invention, and desire to secure by letters patent, is the application of the stamped round part and the solid part (or the moving lid or cover) fitted together as a hinge, which forms a rounded smooth-turned face, and the manner in which the pin is connected with both parts, as herein described, using for that purpose the aforesaid "two pieces, to form a regular curvilinear or round-turned hinge," made of any materials which will produce the intended effect.

There were before the court on the trial, exhibits, showing the alleged invention of the patentee and the alleged infringement. The patentee was allowed to take his exhibits away, without any written order to that effect, and I have

tried in vain at the stores to get one. I produce, however, the inkstand which was alleged to be an infringement; it is similar, I believe, to those on the tables in this court-room.

The plaintiff below sued the defendants for infringements committed during the lifetime of the original patent, and also during the extended term, (Rec., p. 2.)

The defendants pleaded, (in accordance with the practice of the court in which they were sued,) the general issue, and two special pleas, viz:

1st. That the original letters patent were void by reason of false suggestion, and—

2d. That the extension was obtained illegally and fraudulently.

On all of these pleas issue was joined, (Rec., pp. 3, 4.)

The case was tried in March, 1870, and a verdict found for plaintiff, and the damages assessed at $500, (Rec., pp. 4, 5.)

Motions to treble the damages, and for a new trial, were overruled, (Rec., p. 5.)

A motion for a new trial, made before the court in general term, on exceptions taken during the progress of the trial, was overruled, and judgment entered for the plaintiff, and the defendants thereupon brought the case to this court by writ of error, (Rec., pp. 14, 15.)

The defendant in error moved to dismiss the writ for want of jurisdictional value, which motion was overruled. (See 13 *Wallace*, 185.)

The case is now to be heard on the merits.

Assignment of Error.

The plaintiffs in error contend that the court below erred:

A. In giving instructions, and refusing those prayed, concerning the patent, its construction and validity, and —

B. In giving instructions, and refusing those prayed, con-

cerning damages, and the proper method of their assessment.

C. In instructions as to what constituted an infringement.

A.

Concerning the Patent.

I.

One of the issues to be tried was the legality and regularity of the extension.

The plaintiffs in error gave in evidence to the jury the report of the examiner, to whom Nock's application for a reissue was ordered, adverse to granting it and offered to prove that the application itself, and other papers concerning it, were withdrawn from the office. (Rec., pp. 5 and 6.) This the court refused to allow, and erred.

II.

The plaintiffs in error prayed the court to instruct the jury:

That if the jury shall find from the evidence that the application of the plaintiff for an extension of his letters patent was, under the law, referred to the principal examiner having charge of the class of inventions to which said case belonged, and that he reported to the Commissioner of Patents that the invention or improvement secured in the patent was not new or patentable when patented, and that if the Commissioner of Patents thereupon extended said patent without reasons assigned for overruling the report of the examiner, and without a further examination into the claims of the invention or improvement secured by the letters patent to novelty or patentability at the time the patent was secured, then such extension was irregular and illegal, and the plaintiff cannot recover on such extended letters patent. (Rec , p. 8.)

The court erred in refusing to grant this prayer.

III.

The letters patent having been introduced to show what was secured to the patentee, and the defendants (below) having given evidence to the jury tending to prove that in the hinges of the inkstands sold by the defendants, and alleged to be infringements of the plaintiff's said patent, the pin or axis of the hinge was introduced from the outside of the collar, passing through the collar and the loop of the cover, prayed the court to instruct the jury:

That the patentee having, in his specification of the letters patent in controversy, declared that his "hinge is constructed like any other hinge, with the exception only that the pin is laid in the hollow part from the under side, and with soft solder both ends of the pin are soldered fast, and the solid moving lid has the hole for the pin or axis of the hinge drilled through the hinge part, as shown in the pattern corrrectly," unless the jury shall find that the hinges of the inkstands sold by the defendants were so constructed, there is no proof of infringement, and that there is no infringement of the plaintiff's patent if the pin is introduced from the outside of the collar, passing through the collar and the loop of the cover. (Rec., pp. 10, 11, 12.)

The court refused this instruction and erred.

IV.

The court erred in not declaring the patent void for defective specification and false suggestion.

B.

As to the question of damages—

Admitting that the defendant (below) had infringed the patent, what was the pecuniary liability therefor?

I.

The plaintiff (below) having given evidence to the effect that the defendants had sold inkstands having hinges that

were infringements of said plaintiff's patent, to the number of seventy-five dozen, and that the royalty which the plaintiff received for the use of his patent was at the rate of two dollars per gross, prayed the court to instruct the jury:

If the jury shall find a verdict for the plaintiff under the foregoing instructions, they will award him such sum as they shall find to be required to remunerate him for the loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have been necessarily incurred by him in order to establish his right.

The court erred in granting this instruction. (Record, pp. 6, 7.)

II.

The plaintiffs in error having shown that inkstands similar to those sold by them were commonly made and sold by the assignees and licensees of defendant in error up to September, 1867, prayed the court to instruct the jury—

That if they should find from the evidence that the inkstands which form the subject of this patent were commonly made and sold by the assignees and licensees of the plaintiff (below) up to September, 1867, then the plaintiff (below) cannot recover for the sale of any such inkstands sold by the defendant (below.)

The refusal to grant this prayer was error. (Rec. p. 9.)

III.

There is error in the refusal to grant the prayer contained in the fifth bill of exceptions, (Rec., pp. 9, 10,) based on the facts therein set out, viz:

At the trial of this cause, upon the issues above joined, the defendants gave evidence to the jury tending to show that inkstands made in accordance with the plaintiff's said patent were commonly sold in the trade, without being stamped or labeled "Patent," prior and subsequent to Sep-

tember, 1867; and, further, the defendants gave evidence to the jury tending to show that the said defendants, when notified by the said plaintiff that the inkstands they were selling were infringements of his said patent, ceased selling them, and thereupon the defendants' counsel prayed the said justice to instruct the jury:

"That if the jury finds from the evidence that inkstands made in accordance with Nock's patent were commonly sold in the trade, without being stamped or labeled, prior and subsequent to September, 1867, then the defendants are not liable, unless notice was served upon them by the patentee, and damages can only be recovered for sales made after such notice."

IV.

The court had the true rule of damages brought to its notice to the prayer contained in the seventh bill of exceptions, (Rec., p. 13,) and its refusal to give that prayer was error. The bill sets out that—

Upon the trial of this cause upon the issues above joined, the plaintiff having given evidence to the jury tending to show that between September, 1867, and January, 1869, the plaintiff was in possession of and controlled the said letters patent, No. 10,310, issued to the said plaintiff for improvements in hinges to inkstands, which said letters patent were subsequently, viz, on the 10th day of December, 1867, extended for the term of seven years from December 13th, 1867. And further, that during the said period, from September, 1867, to January, 1869, the said defendants had sold about seventy-five dozen inkstands, which were an infringement of said patent. And further, that the plaintiff had obtained from licensees, under the said extended term of his said patent, a royalty of $2.00 per gross.

And thereupon the counsel for the defendants requested the said justice to instruct the jury:

"That if the jury shall find for the plaintiff, the amount of damages assessed shall not exceed the royalty received by the plaintiff from the licensees under the extended patent,

on the number of inkstands and ink-wells proved to have been sold by the defendants between September, 1867, and January, 1869."

Which request the said justice rejected, and refused to so instruct the said jury.

C.

There were two erroneous instructions given to the jury as to the grounds on which the plaintiff below might recover, to be found in the second bill of exceptions, (Rec., p. 7,) one of which came from the court, and the other of which was suggested by counsel.

I.

Among the prayers of the plaintiff (below) which were granted is this:—

That if the jury are further satisfied that since the issuing of said letters patent, and during said term of years, and while the plaintiff was the owner of his said patent, the defendants have made, or caused to be made or sold for use, inkstand covers, or inkstands with covers, which, on principle and construction, are substantially the same as the invention so patented by the plaintiff, then the plaintiff is entitled to recover in this action.

II.

Among the "further instructions" of the court is to be found this:

If the jury shall further find that the inkstands bought and sold by the defendants were an infringement upon the patent of the plaintiff, they will find for the plaintiff, unless they shall further find that the plaintiff himself, or by his assignees, or agents, on consideration, authorized the manufacture and sale of the same.

ARGUMENT.

There are always two questions in a patent suit:

1st. Has the defendant infringed the plaintiff's right; and,

2d. What is the damage he has thereby done the plaintiff.

Essential to the determination of the first question is the preliminary inquiry, whether the plaintiff has any right which can be infringed. That is, *first*, whether he has made any invention; and, *secondly*, whether the invention he has made is covered by the patent he holds.

So far as the record shows, the only proof that Nock ever invented anything in the way of inkstands, or inkstand covers, or hinges for inkstand covers, given in this case, was the patent itself. To it and to its description, specification, and claim, particular attention is invited.

It is only by reading between the lines that it can be ascertained what Nock really claimed.

The patent says he "*has invented a new and useful hinge for inkstand covers*," and grants him the monopoly of making, &c., "*the said hinge, a description whereof is given in the words of the said Nock, in the schedule annexed*," *&c.* (Record page 10, line 46, and page 11, lines 1, 2, 3.)

So we turn to the schedule for Nock's own description, and we find:

"The nature of my invention consists in *providing the inkstand*, or inkwell *cover* with *a curvilinear hinge* on *the top of the inkstand*."

That is the description, or at least a part of it. For further on he says:

"This hinge is constructed like any other hinge, with the exception only that the pin, (*something not before referred to*,) is laid in the hollow part from the under side, and with soft solder both ends of the pin are soldered fast, and the solid

moving lid has the hole for the pin or axis of the hinge drilled through the hinge part, as shown in the pattern correctly."

Now if he means to claim a hinge that has a curvilinear axis, he claims something that does not or cannot exist.

Still another attempt is made to state his invention in his claim which is:

The application of the stamped round part, and the solid part, (or the moving lid or cover,) fitted together as a hinge, which form a rounded smooth turned face; and the manner in which the pin is connected with both parts, as herein described, using for that purpose the aforesaid two pieces, to form a regular curvilinear or round turned hinge.

That is to say, he claims such a combination of parts, and application of another part, theretofore described or hinted at, as will form a mechanical impossibility.

Void, such a patent must be, for false suggestion, and the court should have so held.

"But," it may be objected, "the court was not asked to declare the patent void, nor had power to do so."

The court was asked, as is shown in the assignment of error, A—III, to give a construction to the patent, and the only construction that could stand. The court declined, and gave no construction. It is the Maryland practice, inherited by the Supreme Court of the District of Columbia, to procure the construction of a written instrument from the court by a prayer suggesting a construction.

Evans' Practice, 299.

As to the duty of a court in such cases, it is submitted that the construction of all written instruments introduced in evidence, their legal effect and intendment, that is, is to be given by the court.

And this rule applies to patents as fully as to any other instrument.

Davis vs. *Palmer*, 2 *Brock.*, 308.

The following are a few of the many text-books and cases to which reference might be made in support of the doctrine supported here by the plaintiffs in error, that it was the duty of the court to construe the patent; and if it was so vague and uncertain in its description and claim as to leave it uncertain what was discovered by the patentee—or if it claimed that which did not and could not exist—declare it insufficient to support an action; or if by any process of fair construction it could be made to cover a substantial invention, do so, and state what that invention was.

Curtis on Patents, §§ 222, 239, 242, *and cases cited.*
Parker vs. *Hulme*, 1 *Fish.*, 44, 46.
Union Sugar Refinery vs. *Matthiesen*, 2 *Fish*, 600, 605, 608.
Hill vs. *Thompson*, 1 *Web. Pat. Cas.*, 235, 237.
Haworth vs. *Hardcastle*, 1 *Web. Pat. Cas.*, 480, 485.
Household Co. vs. *Neilson*, 1 *Web. Pat. Cas.*, 673, 678, 679.
Crossley vs. *Beveridge*, 1 *Web. Pat. Cas.*, 112, 117.

The plaintiffs in error do not rely upon the assignments of error A—I, A—II, with the assurance they did before the case of *Goodyear* vs. *Rubber Co.*, 9 *Wallace.*

That case, however, had not been published, if decided, when this case was tried below. In presenting the question then the plaintiffs in error relied upon the authority of *Swift* vs. *Whisen*, 3 *Fish*, 343; 352, and *Grant* vs. *Raymond*, 6 *Pet.*, 218; 248.

Before considering the question of damages involved in the assignment of error under B, the erroneous instructions in C will be briefly noticed.

The court was requested to instruct the jury, and did, that they might find for the plaintiff (below) if they were satisfied that while the plaintiff was the owner of the patent the defendants had sold inkstand covers which, on principle and construction, were the same as the plaintiff's invention. Now, in the statement of evidence introductory to this prayer, there is no statement that the defendants were not licensees under the patent, nor does the prayer exclude that possibility, nor the other possibility that they bought, (to sell again,) from licensees under the patent, the *owner* of which though there be thousand licensees might still be the plaintiff (below.)

The court apparently saw this defect for it made a limitation—

"Unless they shall further find that the plaintiff himself, or by his assignees or agents, *on consideration*, authorized the manufacture and sale of the same."

Now, this is mending bad law with a patch of worse. No consideration whatever is necessary to sustain a license under a patent, by the patentee. Permission to use is all that is necessary, even without resorting to that general dedication to the public which is known as "abandonment."

If there was a patentable invention—very doubtful, and if that invention was so described as to validate the patent—still more doubtful, and if the inkstands sold by the plaintiffs in error were "infringements" of that patent—also doubtful, and if these plaintiffs in error had no authority, either from the patentee, or his licensees, or assignees, there still remains the question of what damages should be assessed against them.

In discussing this question, it is to be borne in mind that these plaintiffs in error are not manufacturers—never made an inkstand of any kind in their lives,—nor wholesale dealers, nor jobbers; but retailers—supplying stationery to individuals and "the departments;" and further, that they

are not persistent infringers, for it is before you that the moment they were notified that the inkstands they sold were infringements of Nock's patent, they stopped selling them.

Under such circumstances, equity and common sense demand a lenient treatment of what was a technical rather than a real violation of Nock's patent, a patent out of his control, as also appears, for at least some time prior to his re-possession of it, and application for extension, in 1867.

Evidence was given that inkstands similar to those sold by Philp & Solomons were commonly made, and sold by the licensees, &c., of Nock, up to September, 1867, when he resumed his patent, and the court refused, though prayed to instruct the jury that Nock could not recover against the plaintiffs in error for any sale of such inkstands.

The licensees had the power to make and sell up to September, 1867, and over what were so made and sold the patentee acquired no right by his resumption of the patent. They had gone into the public market with his permission, and his interest in them, as well as his title to them, was extinguished, in whosesoever hands they might be.

It was in evidence also that the inkstands claimed by Nock were commonly sold in the trade, without any stamp upon them to call attention to their being a patented article. The patent act of 1861, in force when this suit was brought, provides in the 13th section that the patentee is to stamp his patented article "patented, together with the day and year the patent was granted."

On failure of which in any suit for infringement of the letters patent, by the party failing so to mark the article, the right to which is infringed upon, no damage shall be recovered by the plaintiff, except upon proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented.

Here the patent was out of Nock's hands for some time prior to September, 1867, and his assignees, &c., made and

sold inkstands like those sold by Philp & Solomons; and inkstands made in accordance with the patent were on common sale, both before the patent was resumed by Nock, and afterwards, without any of the marks prescribed by law.

It requires but a verbal alteration of Littleton to read—

Though this case be not by express words specified in the said statute, but it is taken by the equitie of the same statute.

And Coke's comment thereon shall suffice—

Equitie is a construction made by the judges, that cases out of the letter of a statute, yet being within the same mischiefe or cause of making the same, shall be within the same remedie that the statute provideth.

Co. Lit., 24 *B.*

So far as the record shows, and in point of fact that showing is correct, there was no proof of specific damage by the alleged infringement on the part of the plaintiffs in error. All that was shown was a sale of 75 dozen, and that the royalty the defendant in error received for the use of his patent was at the rate of $2 per gross; in other words, that he had been damaged by the plaintiffs in error by their withholding royalty from him to the amount of $12.50.

Under these circumstances the court was requested to instruct the jury to confine their verdict to that sum. The court refused to do this, and went on to say that they might find enough to reimburse the defendant in error for all such expenditures as had been necessarily incurred by him in order to establish his right.

This instruction is doubly erroneous; for there was no evidence of any "expenditure" by him, and so it had no foundation in the evidence in the case, and its inevitable effect upon the minds of the jury was to lead them to believe they might lump counsel fees, and such other expenditures as they *inferred*, and out of them make a total. The

jury followed this evident lead of the court, and returned a verdict for forty times the amount proven!

Curtis on Patents, §§ 338, 341, *and cases cited.*
Bell vs. *Daniels*, 1 *Fish.*, 372, 379.
Jenkins vs. *Greenwald*, 2 *Fish.*, 37, 51.
Goodyear vs *Bishop* et al., 2 *Fish.*, 154, 156.
Burdell vs. *Denig*, 2 *Fish.*, 588, 599.
Lewis vs. *Marling*, 1 *Web. Pat. Cas.*, 490, 493, *N* 3.
Seymour vs. *McCormick*, 16 *How.*, 482, 489, 490.

It is submitted, therefore, by the plaintiffs in error that the errors of the court below concerning the patent itself, its validity, and construction, and concerning damages are such as to warrant and demand a reversal of the judgment rendered, and either a dismissal of the suit against them or a new trial.

R. D. MUSSEY,
For Plaintiffs in Error.

Supreme Court of the United States.

No. 278.

DECEMBER TERM, 1872.

PHILP & SOLOMONS

vs.

JOSEPH NOCK.

ERROR FROM THE SUPREME COURT DISTRICT OF COLUMBIA.

The plaintiff below (Nock) sued Philp & Solomons for infringing his patent for an inkstand hinge. The defendants pleaded the general issue, and that the patent was obtained by "false suggestions;" and in the same plea, that "there was no patentable invention described in Nock's specifications and claim;" (pp. 3, 4,) and in the third plea, that "the extension was obtained illegally and fraudulently." There were a verdict and judgment for plaintiff for $500, and the defendants moved for a new trial, upon exceptions to the ruling of the Court; for insufficient evidence; and because of excessive damages. The motion was overruled, and, upon appeal to the general term, affirmed the judgment, and the defendants prosecuted error.

If there be any question properly before this Court, it relates to the rulings upon the instructions to the jury given and refused.

The bills of exception do not show all the evidence in the case, but from them it may be gathered that the plaintiff below proved his letters patent and specifications, and that the defendants had infringed his right by selling seventy-five dozen inkstands. What further facts be proved is not stated.

2. The first bill of exceptions (pp. 5, 6,) shows that the defendants below were allowed to read the report of an examiner, giving his reasons for the non-extension of Nock's patent; and thereupon he offered to prove that the application and papers relating to the extension had been taken from the office, which evidence was excluded. Certainly there was no issue in the pleadings to authorize such proof. It could not have conduced to prove "false suggestions" in obtaining the original patent, or that the original specifications contained no "patentable invention." Nor could it support the third plea, that the "extension was obtained illegally and fraudulently." There is no statement or pretext in the bill of exceptions that such evidence was offered as a foundation for offering secondary evidence. The papers were a record, part of which the defendants read, and there was no affidavit of search, or that a certified copy of the record could not be obtained. The Court might well decline to receive proof, of course unofficial, that the application and other papers relating to the extension had been taken from the files of the Patent office. If so probable a thing had really occurred, the bill of exceptions ought to have shown that the evidence of the proper custodian was offered, and facts should have been stated which would have enabled this Court to decide as to the materiality of the evidence.

The general rule is, that where there was an exception to excluding evidence, the bill of exceptions must show the materiality of the evidence.

(*Rose* v. *San Antonio and Mexican Gulf R. R. Co.*, 31 Tex., 61; *Bryant* v. *Kelton*, 1 Tex., 436. *Hancock* v. *Dimon*, 17 Tex., 372.) And, if it be written evidence, it should be shown substantially what the evidence was.—(*Styles* v. *Gray*, 10 Tex., 504; *Ryan* v. *Jackson*, 11 Tex., 401.)

Where a bill of exceptions does not show why the evidence was excluded, nor what it contained, nor why a continuance was refused, the Court will presume that the judge ruled correctly.—*Greenwade* v. *Walling*, 30 Tex., 378.

And this is only a sequence of the mere general rule, that the ground of objection should be so stated, as to confine the Supreme Court to the same objection; for questions cannot be raised in the appellate court, which were not raised in the court below.—(Doe

v. Natchez Ins. Co., 8 Sm. & Marsh, 208; Gillett *v.* Campbell, 1 Denio, 520; Dickey *v.* Malechi, 6 Mo., 188; Frost *v.* Pryor, 7 Mo., 316; Reab *v.* McAllister, 8 Wend., 109–111; Brogestide *v.* Clark, 5 La., 295; Mandeville *v.* Perry, 6 Call, 78; Lucas *v.* Wane, 12 Sm. & Marsh, 161; Elliott *v.* Piersol, 1 Pet., 328. *Houston* v. *Perry*, 5 Tex., 467.)

With the statement of this general principle, we pass to the second bill of exceptions, which is to the instructions given to the jury, on motion of the plaintiff. (Pp. 6, 7.) If this bill of exceptions recites all the evidence given upon the points, which were the letters patent, the extensions, their continual possession, the infringement, and the usual royalty charged by the plaintiff to dealers, then the instructions were more favorable to the defendants than they had the right to ask; for it put to the jury hypothetically that which the jury should have assumed as proved; it left to them to determine the legal effect of solemn instruments; it allowed it to go behind the letters patent, and to find, without any legal proof upon the subject, whether or not facts, determined by a co-ordinate department of the government, in the exercise of lawful jurisdiction, were facts, that is, whether or not Nock was the first inventor, and if so, whether his invention was useful, according to a test too liberal for the defendants; and then, without any predicate laid in the pleadings, or proved, according to this exception, to determine whether or not the plaintiff might not have parted with a right secured by the constitution and statutes. The objection to this far too liberal instruction was general, and certainly it is free from objections, both as to law and the measure of damages.

3. The 3d bill of exceptions (p. 8) was still more untenable. It virtually assumes that the Commissioner of Patents had no right to overrule the objections of the chief examiner, without assigning reasons therefor, when there was no proof as to whether he assigned reasons, or made an examination or not. The instruction asked the jury to find about a fact not proven; and asked the Court to instruct that an assumed irregularity by an officer was fatal to the rights of the patentee.

The truth is that section 18 of the act of July 4, 1836, (5 Stat. 117, 135; Laws American Digest, Appendix, pp. 76, 77,) contem-

plates no duty for the examiner, but creates a board for which, by the act of 27th May, 1848, § 1, 9 Stat. 231,) the Commissioner of Patents is substituted. And it has been repeatedly held that the decision of the Board of Commissioners, under this section is conclusive within the scope of its authority. (Brooks v. Bicknell, 3 McLean, 258; Wilson v. Rosseau, 4 Hon, 688; Woodworth v. Stone, 3 Story, 753; Colt & Young, 2 Blatchford, 473,474; Battin v. Taggert, 17 How., 84; Clum v. Brewer, 2 Curtis, 518.)

The language of Mr. Justice Nelson is peculiarly applicable to this case: "The jurisdiction of the Commissioner over the application being established, his decision must be regarded as conclusive as to any informalities or irregularities that may have happened in the course of the execution of the duty, and cannot be the subject of examination and review on this motion, the same as if the case was before us on a writ of error or appeal."—(Colt *v.* Young, 2 Blatchford, 473, 474.)

But, in truth, there was no irregularity. The law presupposes, and the exception virtually admits, that the Commissioner had acquired jurisdiction under the statutes, and that the facts as to utility and ~~handiship~~ existed. The novelty and utility of the patent had been determined by the original grant, and nowhere in the statute is a review or any examination by an examiner contemplated. Much less is it contemplated that the Commissioner should assign reasons for his judgment.

4. The 4th bill of exceptions (p. 9) assumes that if inkstands of the plaintiff's invention were sold by the assignees and licensees of the inventor, then the defendants, not being the patentees or licensees of the inventor, nor purchasing from such, had the right to sell *ad libitum*. Or, to state it more simply, it is assumed that as soon as an inventor gives a license for a particular district, he opens "his invention to the piracy of the whole world." To state the proposition in any language is to answer it.

5. The 5th bill of exceptions (pp. 9, 10) is defective in not stating the evidence given. Evidence "tending to show that inkstands made in accordance with the plaintiff's patent were commonly sold in the trade, without being stamped or labelled, prior and subsequent to September, 1867," might have been so weak as not to be worthy of instruction; or the proof might have shown

that other infringers were in market; or, indeed, many cases may be supposed which would render the instructions improper.

6. The 6th bill of exceptions (pp. 11, 13) sets out Nock's letters patent and specifications, and asks the Court to instruct the jury "that the patentee having, in his specification of the letters patent in controversy, declared that his hinge is constructed like any other hinge, with the exception only that the pin is laid in the hollow part from the under side, and with soft solder both ends of the pin are soldered fast, and the solid moving pin has the hole for the pin or axis of the hinge, drilled through the hinge part, as shown in the pattern correctly, unless the jury shall find that the hinges of the inkstand sold by the defendants were so constructed, there is no proof of infringement of the plaintiff's patent if the pin is introduced from the outside of the collar, passing through the collar and loop of the cover."

There is no evidence set forth which connects this instruction. The character of inkstand sold by the infringers is nowhere described. In other words there is no such fullness of statement as shows that the evidence set out was all that was given upon the point; and if other bills of exception can be consulted, they prove that there was evidence tending to prove the acts of infringement. Upon the very issue as to whether there was a violation of the patent or not, the proof of non-identity ought to have been particularly set forth. But the facts constituting the case of the defendants below are wholly omitted. Therefore, it is impossible for this Court to determine what the jury ought to have found as to the question of identity. And in the absence of a statement of facts upon the issue, every presumption is in favor of the correctness of the instruction.

7. The 7th bill of exceptions admits that evidence of infringement was given, and it asks the Court to assume as the measure of damages the inventor's price for royalty.

A trespasser or infringer has no right thus to compound his torts. It was for the jury to determine, under all the circumstances, what damages ought to be awarded.

If there be other points in the case they are such as can duly be discussed at the bar. Certainly they do not rise upon the record. Upon that there seems to be no error.

Respectfully submitted. GEO. W. PASCHAL.

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See Book No 168.